

REMARKS

I. Status of Claims

Claims 2-8 and 32-77 are pending in this application. The Examiner has rejected all pending claims under 35 U.S.C. §103(a) over U.S. Patent No. 6,001,135 to Rondeau et al. ("Rondeau") in view of U.S. Patent No. 5,376,146 to Casperson et al. ("Casperson") and further in view of WO 97/19998 to Aaslyng et al. ("Aaslyng") for the reasons of record. Applicant respectfully traverses this rejection for reasons of record and for the additional reasons set forth below.

II. § 103(a) Rejection over Rondeau in View of Casperson and Further in View of Aaslyng

The Examiner maintains that Rondeau "teaches a hair dyeing composition comprising the cationic dyes as claimed . . . [and] also clearly teaches that quaternary ammonium compounds are used in the hair dyeing composition." Final Office Action at 2. The Examiner, admitting that Rondeau's quaternary ammonium salts do not fall within the scope of those presently claimed, still relies on Casperson for teaching hair dyeing compositions comprising quaternary ammonium salts "similar to the claimed formula." *Id.* He then states that "Casperson clearly teaches that the quaternary ammonium salts are used in the hair dyeing compositions as conditioners [to] improve the lubricity of the hair such as making the hair easy to detangle while wet and feel smooth and readily managed when dry," and Aaslyng teaches that laccase enzymes may damage hair less than other oxidizing agents such as hydrogen peroxide. *Id.* at 2-3. Thus, according to the Examiner, one of ordinary skill in the art would have found it obvious to modify Rondeau by incorporating the quaternary ammonium salts of Casperson and the laccase enzyme of Aaslyng to arrive at the present composition

"with a reasonable expectation of success for improving the condition of the hair as taught by Casperson and to reduce the damage on the hair as taught by Aaslyng." *Id.* at 3. Applicant disagrees.

A. The Examiner has not met his Evidentiary Burden for Proving a *Prima Facie* case

First, as Applicant has previously reiterated on the record in detail, the Examiner has failed to meet the high evidentiary standard for establishing a *prima facie* case of obviousness. The present Final Office Action fails to elucidate in any greater detail than the previous Office Actions the Examiner's underlying rationale for his conclusory statement that "it would have been obvious to the skilled person in the art to be motivated to modify the primary reference"

As the Federal Circuit has mandated, the record **must contain** "substantial evidence" to support a determination of obviousness. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). "The PTO . . . **must also explain the reasoning** by which the findings [of obviousness] are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002) (quotation marks omitted; emphasis added). Moreover, this reasoning must be factually supported by "objective evidence of record." M.P.E.P. § 2142; *In re Lee*, 277 F.3d at 1343.

Because the Examiner has failed to explain and factually support the reasoning behind his broad conclusion, Applicant again respectfully requests the Examiner point out on the record specifically where in the references or the knowledge generally available to those of ordinary skill in the art, one would find the motivation to combine references teachings with a reasonable expectation of success. If the Examiner cannot

do this, then Applicant respectfully asserts that a *prima facie* case of obviousness has not been established.

B. The Examiner has not Shown any Motivation to Combine the References

As the Examiner knows, in order to establish a *prima facie* case of obviousness, the Examiner must show not only a motivation to modify the reference or combine reference teachings, but also a reasonable expectation of success. See M.P.E.P. §2143. Here, the Examiner has done neither.

First of all, as has been established in detail on the record, the Examiner has failed to show that any of the cited references provide any motivation to modify or combine reference teachings. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995).

The primary reference, Rondeau, instead of providing a teaching or suggestion for its modification, actually teaches away from making the Examiner's proposed modification. For example, whereas the at least one oxidation base is optional in the present invention, the composition in Rondeau **must contain** at least one oxidation base, which functions "when combined with oxidizing products [to] give rise to colored compounds and dyes by a process of oxidative condensation." Rondeau, col. 1, ll. 40-42. In contrast, while Applicant's composition may certainly contain at least one oxidation base, this compound is not necessarily required for obtaining the improved dyeing properties of the claimed invention set forth, for example, in the present specification at page 3. Yet the Examiner continues to rely on Rondeau, which nowhere

teaches or suggests that were the oxidation base to be omitted, the composition would still retain its function.

Thus, no motivation to combine can exist where the Examiner simply picks and chooses an essential component from one reference (here, Rondeau), leaving the others behind, only to combine it with another arbitrarily chosen component from a second reference (here, Casperson). The law condemns that exact practice: "It is impossible with the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *In re Wesslau*, 353 F.2d 238, 241 (C.C.P.A. 1965). Yet this is exactly the practice the Examiner has followed, picking one ingredient from Rondeau, isolated from its other essential ingredients, and combining it with one ingredient from Casperson, isolated from its other essential ingredients. The Examiner has not, as indeed he cannot, point to any suggestion or motivation within these references or within the knowledge generally available to those of ordinary skill in the art to make this combination.

Further, the Examiner has not shown that Aaslyng in any way cures this deficiency or supplies the requisite motivation to combine references. Therefore, Applicants respectfully assert that no *prima facie* case of obviousness has been established and the present rejection should be withdrawn.

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C. The Examiner has not Shown a Reasonable Expectation of Success

As discussed above, the Examiner must, in addition to showing a motivation to combine references, show why one of ordinary skill in the art would have had a reasonable expectation of success in making the proposed combination. This the Examiner has not done. Instead, the Examiner has taken components the prior art dictated were mandatory and made them optional. Then the Examiner has asserted that, even absent these mandatory components, one of ordinary skill in the art would still have a reasonable expectation that the proposed combination would be successful. To the contrary, one of reasonable skill in the art would not expect a combination that optionally omits an essential ingredient to be successful.

Moreover, the components of the present invention, *i.e.*, the cationic direct dyes and the quaternary ammonium salts, "are capable of giving intense and only slightly selective colours which are quite resistant ... to the various attacks to which the hair may be subjected." Specification at p. 3. Such improved properties are neither taught nor suggested by Casperson or Aaslyng, respectively. Instead, Casperson teaches only that the quaternary ammonium salts "function . . . as surfactants [and] as hair conditioners." Casperson does not indicate that the quaternary ammonium salt, while acting as a surfactant, has any effect on the color intensity, selectivity, and resistance. This showing of an unexpected property should supercede any allegation of a reasonable expectation of success. Rather, as the Examiner himself admits, if any reasonable expectation of success exists, it is "the reasonable expectation of success **for improving the condition of the hair as taught by Casperson,**" Final Office

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Action at 3 (emphasis added), and not a reasonable expectation of enhanced dyeing properties.

The same rationale surrounds Aaslyng. The Examiner admits that the reasonable expectation of success, if it exists at all, would be "to reduce the damage on the hair as taught be Aaslyng." *Id.* Aaslyng cannot provide the requisite expectation of success because Aaslyng is silent as regards improving dyeing properties. *In re Dow Chem. Co. v. Am. Cyanamid, Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988) ("[T]he expectation of success must be found in the prior art, not in applicant's disclosure."). Thus, when combining the laccase enzyme of Aaslyng with the compounds of Rondeau and Casperson, one would have no reasonable expectation of success.

III. Conclusion

Applicant respectfully requests that this Response under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 2-8 and 32-77 in condition for allowance. Applicant further submits that this Response should allow for immediate action by the Examiner, and that the entry of this Response would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

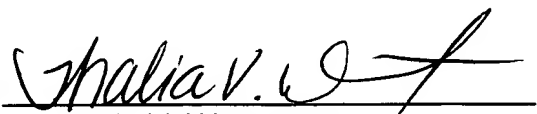
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: November 3, 2003

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